

REMARKS

The Official Action mailed June 2, 2008, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time. Accordingly, the Applicant respectfully submits that this response is being timely filed.

The Applicant notes with appreciation the consideration of the Information Disclosure Statements filed on September 20, 2006 and December 12, 2006.

Claims 1-28 were pending in the present application prior to the above amendment. Claims 1-7, 10, 11, and 14-18 have been amended to better recite the features of the present invention. The Applicant notes with appreciation the indication of the allowability of claims 7 and 14-18. Accordingly, claims 1-28 are now pending in the present application, of which claims 1-6, 10 and 11 are independent. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

The Official Action rejects claims 7 and 14-18 under 35 U.S.C. § 112, second paragraph asserting that in claims 7 and 14-18 it is not understood how the "connecting terminal" can control an amount of charge on line 2 since the connection terminal is only an "end" or an "input," which cannot perform the function of controlling charge.

While the Applicant respectfully disagrees with this assertion, the claims have been amended to delete "for controlling an amount of charge accumulated in the floating gate" from the claims.

The amendments are merely clarifying in nature, and should not in any way affect the scope of protection afforded the claims for infringement purposes, particularly under the Doctrine of Equivalents. The Applicant respectfully submits that amended claims 7 and 14-18, when read in light of the specification, are definite. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 112 are in order and respectfully requested.

The Official Action rejects claims 1, 2, 8, and 9 as anticipated by U.S. Patent No. 6,670,679 to Hirata. The Applicant respectfully traverses the rejection because the Official Action has not established an anticipation rejection.

As stated in MPEP § 2131, to establish an anticipation rejection, each and every element as set forth in the claim must be described either expressly or inherently in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

The Applicant respectfully submits that an anticipation rejection cannot be maintained against the independent claims of the present application. Specifically, claims 1-2 recite that a side surface of the floating gate is covered with a third insulating film. It is respectfully submitted and acknowledged in the Official Action that Hirata fails to disclose a side surface of the floating gate covered with a third insulating film. See, Paper No. 20080528, Page 4, lines 3-4.

Since Hirata does not teach all the elements of the independent claims, either explicitly or inherently, an anticipation rejection cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 102 are in order and respectfully requested.

The Official Action rejects claims 1-6, 8-13, and 19-28 as obvious based on the combination of Hirata and U.S. Patent No. 6,300,656 to Ueno. The Applicant respectfully submits that a *prima facie* case of obviousness cannot be maintained against the independent claims of the present application, as amended.

As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the

prior art to produce the claimed invention where there is some reason to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). As noted in MPEP § 2143.01, Part V, if a proposed modification renders the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Also, as noted in MPEP § 2143.01, Part VI, if a proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

The prior art, either alone or in combination, does not teach or suggest all the features of the independent claims, as amended. Independent claims 1-6, 10 and 11 have been amended to recite wherein the floating gate is electrically floating. For the reasons provided below, Hirata and Ueno, either alone or in combination, do not teach or suggest the above-referenced features of the present invention.

The Applicant respectfully submits that the alleged floating gate electrode 55 of Hirata is connected to a source line or ground (see Figures 4-7 and 9-12) such that the floating gate is not electrically floating. Moreover, the connection of the floating gate electrode to a source line or ground is an essential limitation of Hirata's invention. See Summary of the Invention, column 4, lines 5-24. Hirata appears to have as its intended function a protective circuit having a "floating gate connected to the constant potential line or a first line" or "a floating gate connected to a ground line."

Ueno does not cure the deficiencies in Hirata. The Official Action acknowledges that "Hirata does not disclose that a side surface of the floating gate is covered with a third insulation film, and a plurality of transistors are connected in series so as to have the same forward current direction." It relies on Ueno to allegedly teach "a MOS transistor is formed with a floating gate (4), a control gate (6), insulating films (3,5), and a third insulating film (7) covering sides surface of the floating gate (4)..." However, Hirata and Ueno, either alone or in combination, do not teach or suggest all of the limitations of the claims, as amended, including a floating gate that is electrically floating.

In addition, the Applicant respectfully submits that modifying Hirata with the floating gate electrodes 4 of Ueno would render Hirata unsatisfactory for its intended function of providing a protective circuit, as stated above, if doing so would potentially result in a floating gate that is "electrically floating." Therefore, the Applicant respectfully submits that Hirata, either alone or in combination with Ueno, does not teach or suggest a floating gate which is electrically floating and that the references cannot be combined in such a way as to teach all the claim limitations of the present invention.

Since Hirata and Ueno do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,


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